

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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MERCEDES-BENZ USA, LLC.  
Petitioner,

v.

NEO WIRELESS, LLC  
Patent Owner

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Case IPR2023-00079  
Patent US 10,965,512

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**PATENT OWNER'S RESPONSE  
TO PETITIONER'S MOTION FOR JOINDER**

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## I. INTRODUCTION

Patent Owner Neo Wireless, LLC hereby responds to Petitioner Mercedes-Benz USA, LLC's ("Mercedes") Motion For Joinder (Paper 3, "Mot.") of this IPR with IPR2022-01539 filed by Volkswagen Group of America, Inc. ("Volkswagen"). This motion is timely under the Board's order and extension granted by email on November 21, 2022.

"Joinder may be authorized when warranted, but the decision to grant joinder is discretionary." *Sony Corp. of Am. v. Network-1 Security Sols., Inc.*, IPR2013-00386, Paper 16, 3 (July 29, 2013). As moving party, Mercedes has the burden to establish entitlement to relief. 37 C.F.R. §§ 42.20(c), 42.122(b).<sup>1</sup>

If the Board institutes review in this case, joinder should only be granted with additional conditions limiting Mercedes's participation as joined understudy petitioner, such as those the Board has imposed in other cases, to reduce the inarguable burden the requested joinder will create in these speedy proceedings.

Mercedes concedes that measures limiting its joined participation are appropriate, and pre-emptively "agrees" to several such limits. Mot., 3, 7-8. The

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<sup>1</sup> The Motion is moot if review of Mercedes's or Volkswagen's Petition is denied. *See Synaptics Inc. v. Amkor Tech., Inc.*, IPR2017-00085, Paper 12, 11 (Apr. 18, 2017). This Response assumes, *arguendo*, institution of both petitions.

Board should, however, grant joinder only with further limits in addition to these.

At the very least, Patent Owner respectfully submits that the Board should grant joinder only on the further conditions:

- (1) That Mercedes be denied any right to participate in the joined proceeding, including filing papers, engaging in discovery, or participate in depositions and oral argument, jointly or otherwise, without first obtaining authorization from the Board; In other words, Patent Owner requests that the Board strictly hold Mercedes to a silent understudy role;
- (2) That Mercedes' exhibits, including its separate purported expert declaration (Ex. 1038), not be added to the record of this case, and that Mercedes have no right as understudy petitioner to submit any separate exhibits or other materials; and
- (3) If the Board rejects Patent Owner's condition (1) immediately above, and grants Mercedes a right to jointly participate, that Volkswagen be shown to have accepted the role Mercedes has proposed that it will play.

In the absence of clarity on what "understudy" means, granting joinder would create unacceptable risks of making the original case, if instituted, substantially more complicated, expensive, and unfair. Therefore, unless the promised "understudy" role is expressly clarified as requested above, and as

discussed in greater detail below, Patent Owner respectfully opposes granting Mercedes' joinder request.

**II. IF JOINED, MERCEDES SHOULD HAVE NO RIGHT TO TAKE ACTIONS WITHOUT PRIOR BOARD AUTHORIZATION.**

As in past proceedings in which parties have been permitted to join as understudy petitioners, the Board should grant Mercedes's joinder request only if Mercedes has no right to participate without express prior Board authorization.

Moreover, as further explained *infra* §§ III-IV, while Mercedes has “agreed” to let Volkswagen take the “lead” (Mot., 3), Mercedes presents no proof that Volkswagen agrees to the limitations Mercedes says Volkswagen will follow, and furthermore, Mercedes has not promised not to submit its own separate evidence. Indeed, Mercedes has already begun to submit its own separate evidence, including separate witness testimony, and, if joinder were granted, may continue to separately proffer more.

In light of such factors, as well as the fact that Mercedes has already agreed that if joined it will submit no separate arguments—essentially, to act as an understudy to Volkswagen—if joinder is granted, there is no apparent reason why Mercedes should be given any right to take any action in the proceedings without prior express Board permission.

In similar factual circumstances, the Board’s past remedy for these concerns, where it has not denied the joinder request altogether, has been to allow joinder only on condition that the joining petitioner has ***no*** right to participate or submit ***any*** materials or arguments without express permission from the Board. For example, in *GlobalFoundries U.S. Inc. v. Godo Kaisha IP Bridge I*, IPR2017-00919, the petitioner seeking joinder made promises essentially similar to Mercedes’s. The petitioner promised that, if joinder were granted, it would stay “in a circumscribed ‘understudy’ role without a separate opportunity to actively participate,” and “w[ould] not file additional written submissions, nor . . . pose questions at depositions or argue at oral hearing without permission of” the first petitioner. *Id.*, Paper 12, 8-9 (June 9, 2017).

The Board “agree[d] with Patent Owner, though, that given its ‘understudy’ role, Petitioner should be permitted to file papers, engage in discovery, and participate in depositions and oral argument ***only after obtaining authorization from the Board***, not [the first petitioner].” *Id.*, 9. The Board therefore granted the petitioner’s motion for joinder only on the condition that the petitioner would have no right to participate in the joined proceedings at all, and would have to contact the Board to request permission before taking any action. *See id.*

If joinder were to be granted here, the same condition should be imposed as in *GlobalFoundries*. There would be no more justification for Mercedes to have

any right to participate than in that case. As in *GlobalFoundries*, the Board should not grant Mercedes's joinder request except, *inter alia*, under the condition that Mercedes be limited to the role of a silent understudy, with no right to file papers, engage in discovery, or participate in depositions and oral argument without first obtaining authorization from the Board. The Board should strictly hold Mercedes to this silent understudy role.

### **III. MERCEDEZ-BENZ USA SHOULD BE PROHIBITED FROM OFFERING ITS OWN SEPARATE EVIDENCE.**

Regardless of other restrictions the Board places on Mercedes, if its joinder request is granted, Mercedes' exhibits in this case, including its separate witness declaration, should not become exhibits in this case, and Mercedes should be granted no right to file any exhibits in the joined case.

Mercedes pledges that if joined, it will refrain from certain independent action, including that it will "agree[] to proceed solely on the grounds, evidence, and arguments advanced, or that will be advanced, in the Volkswagen IPR if it is instituted." (Mot., 3). Mercedes does *not* agree to not file separate exhibits.<sup>2</sup>

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<sup>2</sup> Or, for that matter, to not serve *proposed* exhibits. Compare, e.g., *Johns Manville Corp. v. Knauf Insulation, Inc.*, IPR2015-01453, Papers 16, 35, 36



Indeed, Mercedes has of course already begun to file separate exhibits, including an expert declaration signed by Mr. Bruce McNair, whose testimony does not appear as an exhibit in the Volkswagen IPR. Ex. 1038.

To be sure, Mercedes “agrees to proceed solely on the grounds, evidence, and arguments advanced, or that will be advanced, in the Volkswagen IPR if it is instituted.” Mot., 3, 6-7. But Mercedes does not agree not to rely on Mercedes’s separate witness (Mr. Bruce McNair), and has not limited itself, or Volkswagen, from presenting different arguments with respect to Mercedes’s separate witness.

In sum, adding Mr. McNair’s declaration to the record would be contrary to the rules governing *inter partes* reviews, designed “to secure the just, speedy, and inexpensive resolution of every proceeding.” 37 C.F.R. § 42.1(b).

All of Mercedes’ other separately filed exhibits, in addition to the McNair declaration, should be required to be withdrawn and should not become part of the record of the joined proceedings. Notably, almost all of Mercedes’s other exhibits (Ex. 1001 to Ex. 1034) are identical to exhibits Volkswagen has previously filed. The rules generally deny parties the right to the filing of duplicative exhibits without express Board authorization. *See* 37 C.F.R. § 42.6(d) (“A document

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(PTAB Mar. 14, Jun. 27, & Jul. 26, 2016) (Board had to rule on two subpoena requests because party served supplemental information, including testimony).

already in the record of the proceeding must not be filed again, not even as an exhibit or an appendix, without express Board authorization.”)

In other proceedings, the Board has granted joinder only on the condition that the joined petitioner use the witness declaration of the existing party, and indeed that, if it has filed a declaration, that the declaration be withdrawn. *See, e.g., Mylan Pharms. Inc. v. Janssen Oncology, Inc.*, IPR2016-01332, Paper 21, 9-11 (Jan. 10, 2017) (denying joinder largely because of different experts); *Argentum Pharma. LLC v. Janssen Oncology Inc.*, IPR2016-01317, Paper 9, 9 (Sep. 19, 2016) (requiring joining petitioner to withdraw declaration of its expert and rely solely on declaration testimony of first petitioner’s expert); *Sony*, IPR2013-00386, Paper 16, 7 (denying joinder because, *inter alia*, “Petitioners also include with their Petition a declaration from [a new expert declarant], which likely would increase the amount of discovery (e.g., depositions) that would be required if joinder is permitted.”) (citation omitted). Mercedes’s joinder request should be granted only on, *inter alia*, this condition.

#### **IV. MERCEDES-BENZ USA’S PROMISES OF COOPERATION BY VOLKSWAGEN ARE UNSUBSTANTIATED AND INSUFFICIENT.**

Finally, Mercedes’s request relies heavily on assurances as to how Volkswagen, the petitioner in IPR2022-01539, will act in the “consolidated” proceedings Mercedes proposes. Mot., 7-8. But Mercedes offers no substantiation

of those assurances. Mercedes does not aver that Volkswagen has agreed to abide by them, or that it has spoken to Volkswagen at all.

In its Motion for Joinder, Mercedes asserts, *inter alia*, that:

- a. all filings by [Mercedes] in the Volkswagen IPR shall be consolidated with the filings of the Volkswagen IPR petitioner, unless a filing concerns issues solely involving [Mercedes];
- b. [Mercedes] shall not be permitted to raise any new grounds not instituted by the Board in the Volkswagen IPR, or introduce any argument or discovery not introduced by the Volkswagen IPR petitioner;
- c. [Mercedes] shall be bound by any agreement between Patent Owner and the Volkswagen IPR petitioner concerning discovery and depositions; and;
- d. [Mercedes] at deposition shall not receive any direct, cross examination, or redirect time beyond that permitted under either 37 C.F.R. § 42.53 or any agreement between Patent Owner and the Volkswagen IPR petitioner.

Mot., 7-8.

However, Mercedes offers no evidence or averments substantiating that Volkswagen has agreed to any of this. Mercedes says that it “agrees” to all these conditions, but nowhere avers that **Volkswagen** agrees to these conditions. *See id.*

The risks of disruption if Volkswagen has not agreed to the role and the restrictions that Mercedes proposes are manifest. For example, if joinder is

granted, then in addition to making “consolidated” filings with Mercedes, as Mercedes “agrees” to do in its Motion, Volkswagen could also make separate, additional arguments, and file additional evidence and papers, that are *not* “consolidated” with Mercedes.

The Board has required such promises of post-joinder cooperation from a first petitioner to be substantiated if joinder is granted. *Compare, e.g., Samsung Elecs. Co. v. Arendi S.A.R.L.*, IPR2014-01144, Paper 11, 6 (Oct. 2, 2014) (denying joinder where, *inter alia*, joinder motion was silent as to whether first petitioner had agreed to cooperate as promised), *with, e.g., Lupin Ltd. v. Senju Pharm. Co., Ltd.*, IPR2015-01871, Paper 13, 4-5 (Jan. 25, 2016) (granting joinder after petitioners substantiated their agreement to cooperate).

The absence of proof that Volkswagen has agreed to its competitor Mercedes’s proposed terms of joint participation weighs in favor of denying Mercedes the right to participate without first obtaining permission of the Board. *See supra* § II. However, if joinder is granted as Mercedes has proposed, it should be granted only on the condition that Mercedes’s assertions of Volkswagen’s cooperation (regarding consolidated filings) are substantiated.

## **V. CONCLUSION**

For the reasons given above, Patent Owner respectfully urges that joinder not be granted on the basis of Mercedes’s pledge of “understudy” status, in the

absence of clarity as to what that status means. Patent Owner respectfully submits that, if Mercedes's petition is instituted, joinder should be granted only with the conditions described above.

Respectfully submitted,

/ Kenneth J. Weatherwax /

Date: January 20, 2023

Kenneth J. Weatherwax, Reg. No. 54,528  
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**CERTIFICATE OF SERVICE**

The undersigned hereby certifies that the following documents were served on the date below and to the addresses listed below:

**PATENT OWNER'S RESPONSE TO PETITIONER'S MOTION  
FOR JOINDER**

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Respectfully submitted,

\_\_\_\_\_/ Robert Pistone /\_\_\_\_

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